

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars:

1. Claim rejection under 35 U.S.C. §112, 2<sup>nd</sup> paragraph

With respect to the rejection of claims 1-3 under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, Applicant respectfully submits that support for the claimed range "50 $\mu$ m<C500 $\mu$ m" can be found in, e.g., page 13, line 25 of the original specification. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the §112, 2<sup>nd</sup> paragraph, rejections of claims 1-3.

2. Rejections under 35 U.S.C. §103(a)

With respect to the rejection of claims 1-2 under 35 U.S.C. §103(a) as being unpatentable over Leifeld (GB2245604), and with respect to the rejection of claim 3 under 35 U.S.C. §103(a) as being unpatentable over Leifeld in view of Bobkowicz (US 3,924,396), Applicant respectfully traverses the rejection at least for the reason that Leifeld and Bobkowicz, combined or separately, fail to teach, disclose, or suggest all of the limitation recited in the rejected claims.

Leifeld discloses that the clearance between leading ends of needle blades and an internal peripheral surface of a casing is set to range from 0.5 mm to 5 mm. In contrast, as recited in claim 1, Applicant's claimed range for clearance "C" is in a range of 50  $\mu$ m  $\leq$  C  $\leq$  500  $\mu$ m, which is clearly smaller than that of Leifeld. As discussed below, Applicant respectfully submits that the particular range is critical, and that the claimed range achieves unexpected results relative to the prior art range." See *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See also MPEP § 2144.05 Obviousness of Ranges.

When a PTFE uniaxially drawn film is rubbed and chopped, fibers strongly charge negatively, and as a result, they tend to adhere to a metal case in which the needle blade roll is stored. When the clearance becomes larger, the result of sweeping and dropping the fibers by the airstream generated with the rotation of the needle blade or by the twine of fibers is decreased or

diminished. Accordingly, the amount of the fibers attached to the internal side of the metal case is increased. As a result, after a certain amount of fibers are accumulated in the case, the fibers fall periodically on an artificial cotton, and subsequently, several bundles of fibers exist on the artificial cotton. Therefore, the quality of the artificial cotton is deteriorated.

Further, when the clearance becomes wider and wider, the opportunity of a film and a needle blade being in contact with each other is decreased, thereby making fibers thicker and longer. Hence, this also deteriorates the quality of the products.

The presently claimed invention is characterized in that when a PTFE uniaxially drawn film is used, the range for clearance "C" is set to be  $50\text{ }\mu\text{m} \leq C \leq 500\text{ }\mu\text{m}$ . The above problem does not occur in the presently claimed invention.

In contrast with Applicant's claimed invention, Leifeld does not appear to recognize the aforementioned problems and, therefore, does not have such a desire to solve the problems by having the clearance C in the same range or even in an overlapping range.

The requirements for establishing a *prima facie* case of obviousness, as detailed in MPEP § 2143 - 2143.03 (pages 2100-122 - 2100-136), are: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the teachings; second, there must be a reasonable expectation of success; and, finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

Further, according to MPEP §2141(I), Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the

circumstances surrounding the origin of the subject matter sought to be patented.

Moreover, according to MPEP §2141(II), when applying 35 U.S.C. §103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

Applicant respectfully submits that Leifeld fails to teach, disclose, or suggest Applicant's claimed range of  $50\text{ }\mu\text{m} \leq C \leq 500\text{ }\mu\text{m}$ , and that by relying on Leifeld the Examiner has not adhered to tenets B and C shown above.

With respect to Bobkowicz, the reference also fails to teach, disclose, or suggest Applicant's claimed range of  $50\text{ }\mu\text{m} \leq C \leq 500\text{ }\mu\text{m}$ . Hence, even if Bobkowicz were combined with Leifeld, the combination of Leifeld and Bobkowicz does not teach, disclose, or suggest all of the claimed features.

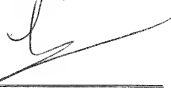
In view of the arguments set forth above, Applicant respectfully requests reconsideration and withdrawal of the §103(a) rejection of claims 1-3.

3. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is requested that claims 1-3 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's representative, the Examiner is invited to contact the undersigned at the numbers shown.

Respectfully submitted,



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